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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,256	12/21/2001	Thomas N. Turba	RA5447 (33012/335/101	2316

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EXAMINER
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ART UNIT	PAPER NUMBER
2165	

DATE MAILED: 01/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 October 2005*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Remarks

1.   The Amendment filed on October 11, 2005 has been received and entered. Claims 1-25 are pending.

Double Patenting

2.   The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3.   Claims 1-25 are provisionally rejected under the judicially created doctrine of double

patenting over claims 1-20 of copending application Serial No. 10/027,066 and that of claims 1-

25 of copending application Serial No. 10/028,253. This is a *provisional* double patenting

rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless

(e) the invention was described in a patent granted on an application for patent by another
filed in the United States before the invention thereof by the applicant for patent, or on an
international application by another who has fulfilled the requirements of paragraphs (1), (2), and
(4) of section 371 (c) of this title before the invention thereof by the applicant for patent.

5.   Claims 1, 6, 7, 11, 12, 16, 17, 18, and 21 are rejected under 35 U.S.C. 102 (e) as being

anticipated over Roth (U.S. Pub. No. 2003/0041053 A1).

As to claim 1, Roth discloses an a data processing system comprising:

a.   a legacy data base management system having a command language and having

an internal format incompatible with an XML document coupled to a publicly accessible digital

data communication network

b.   a. a user terminal (See page 7, paragraph 0087, wherein "terminal" reads on

"client computer") coupled to said legacy data base management system See pages 2-3,

paragraphs 0020-0021) via said publicly accessible digital data communication network (See

pages 3, paragraph 0044, wherein "publicly accessible digital data communication network"

reads on "Internet" deemed to connect the client-server) which generates an XML service for requesting said legacy data base management system to process said XML document in a specified manner (See page 7, paragraphs 0085-0086, wherein "service request" is accessing the relational database to perform a search, wherein "legacy data base management system" is deemed to run on SQL relational database for database management);

    c.   an input definition facility responsively coupled to said legacy data base management system (See Figure 6, 508, shows "SQL Statement Generation Module" stored on a client terminal making a request to relational database both connected together through a network, also see page 2, paragraph 0020) which defines the input coming into said XML service and loads said XML document for said XML service to said legacy data base management system for processing (See page 5, paragraph 0062, wherein "defines" reads on "specification", and wherein "legacy database management system" is deemed to run on the relational database).

    As to claim 6, <u>Roth</u> discloses an apparatus comprising:

    a.   a publicly accessible digital data communication network (See pages 3, paragraph 0044, shows the Internet);

    b.   a data base management system having an internal format different from XML responsively coupled to said publicly accessible digital data communication network request (See Figure 6, 160, shows relational database residing within the server computer receiving requests in SQL Not XML, wherein "legacy database management system" is deemed to run on the relational database);

  c. a facility which generates an input service requesting that said data base

management system process an XML document (See page 7, paragraphs 0085-0086, wherein

"service request" is accessing the relational database to perform a search initially in XML

request, wherein "legacy data base management system" is deemed to run on SQL relational

database for database management); and

  d. a converter which translates said input service into said internal format (See page

7, paragraph 0089, wherein "internal format" reads on "SQL") and presents said translated input

service to said data base management system (See Figure 6, shows SQL input from client to

server, and wherein "legacy database management system" is deemed to run on the relational

database).

  As to claims 7, and 18, <u>Roth</u> discloses wherein said input service further comprises an

XML input service (See page 4, paragraph 0056, shows "XML send/receive").

  As to claim 11, <u>Roth</u> discloses a method of supplying an input service to a legacy data

base management system having an internal format comprising:

  a. retrieving a sample document from a repository of said legacy data base

management system (See page 4, paragraph 0057);

  b. editing said document into a desired input service request (See page 5, paragraph

0060, wherein "editing" reads on "translates", and wherein "input service" reads on "XML

results");

c.   converting said desired input service into said internal format (See page 7,

paragraph 0089, wherein "internal format" reads on "SQL"); and

d.   presenting said converted desired input service to said legacy data base

management system for honoring (See page 7, paragraphs 0085-0086, wherein "input service" is

accessing the relational database to perform a search, wherein "legacy data base management

system" is deemed to run on SQL relational database for database management).

As to claim 12, Roth discloses wherein said sample document further comprises an XML

document (See page 4, paragraph 0056, shows "XML send/receive").

As to claim 16, Roth discloses an apparatus comprising:

a. means for storing a sample input service (See page 4, paragraph 0057);

b. means responsively coupled to said storing means for retrieving said sample input

service (See page 4, paragraph 0054);

c. means responsively coupled to said retrieving means for editing said sample input

service into a desired input service (See page 5, paragraph 0060, wherein "editing" reads on

"translates", and wherein "input service" reads on "XML results");

d. means for providing legacy data processing management services honoring (See page

7, paragraphs 0085-0086, wherein "input service" is accessing the relational database to perform

a search, wherein "legacy data base management system" is deemed to run on SQL relational

database for database management); and

e. means responsively coupled to said editing means and said providing means for

transferring said desired input from said editing means to said providing means (See page 3,

paragraph 0023, also see page 8, paragraphs 0092-0093).

As to claim 17, <u>Roth</u> discloses wherein said storing means further comprises a repository

(See Figure 6, 160, relational database, wherein "repository means" reads on "relational

database").

As to claim 21, <u>Roth</u> discloses an apparatus for communicating within a data processing

environment comprising:

a.   a user terminal which transfers an XML message and receives a corresponding

data processing response (See Figure 6, 102, client computer);

b.   a converter which converts said XML message into a data processing service

request including an ordered sequence of native command language statements and a plurality of

input parameters (See page 7, paragraph 0089, wherein "internal format" reads on "SQL", also

see page 5, paragraphs 0066-0068, wherein "native command language" reads on "the Operator

box" part of SQL language being specified prior to execution of the search); and

c.   a legacy database management system responsively coupled to said user terminal

(See Figure 6, wherein "legacy data base management system" is deemed to run on SQL

relational database for database management) via a publicly accessible digital data

communication network (See pages 3, paragraph 0044, shows the Internet) which honors said

data processing service request by executing said ordered sequence of native command language

statements and utilizing said plurality of input parameters and generating said corresponding data

processing response (See page 5, paragraph 0060, wherein "native command language

statements" reads on "SQL").

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

7.   Claims 2-5, 8-10, 13-15, and 19-20 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Roth (U.S. Pub. No. 2003/0041053 A1) in view of Kiernan et al. (U.S. Patent

No. 6,934,712 B2).

As to claims 2, 8, 13, and 19, Roth does not teach wherein said XML service further

comprises a plurality of variables.

Kiernan et al. teaches wherein said XML service further comprises a plurality of

variables (See Kiernan et al. column 8, lines 28-38).

Therefore it would have been obvious to one having ordinary skill in the art at the time

the invention was made to have wherein said XML service further comprises a plurality of

variables because it is well known in the art that the WHERE statement of the XML service is

defines the structure of the result of the XML query (See Kiernan et al. column 8, lines 28-30).

As to claims 3, 14, and 20, <u>Roth</u> does not teach wherein said XML service further comprises a plurality of tables.

<u>Kiernan et al.</u> teaches wherein said XML service further comprises a plurality of tables (See <u>Kiernan et al.</u> column 2, lines 41-45, also see <u>Kiernan et al.</u> column 6, lines 7-10, also see <u>Kiernan et al.</u> column 14, lines 38-46).

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have wherein said XML service further comprises a plurality of tables because it is well known in the database art that XML services runs over a plurality of tables where the data is being stored.

As to claims 4, and 15, <u>Roth</u> as modified discloses wherein said XML service further comprises executable script (See <u>Kiernan et al.</u> column 14, lines 61-66, also see <u>Roth</u> page 4, paragraph 0053).

As to claims 5, and 10, <u>Roth</u> as modified discloses wherein said publicly accessible digital data communication network further comprises the Internet (See <u>Roth</u> pages 3, paragraph 0044).

As to claim 9, <u>Roth</u> as modified discloses wherein said facility further comprises a plurality of sample XML messages (See <u>Roth</u> page 4, paragraph 0056, wherein "XML send/receive" deemed to include plurality of XML messages).

8.   Claims 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over <u>Roth</u> (U.S.

Pub. No. 2003/0041053 A1) in view of <u>Dombroski et al.</u> (U.S. Pub. No. 2003/0023463 A1).

As to claim 22, <u>Roth</u> does not teach wherein said legacy database management system

further comprises a mainframe computer.

<u>Dombroski et al.</u> teaches wherein said legacy database management system further

comprises a mainframe computer (See <u>Dombroski et al.</u> page 6, paragraph 0061).

Therefore it would have been obvious to one having ordinary skill in the art at the time

the invention was made to have a legacy DBM (i.e. SQL) running mainframe computers (See

<u>Dombroski et al.</u> page 6, paragraph 0061).

As to claim 23, <u>Roth</u> as modified discloses wherein said user terminal further comprises

an industry standard personal computer (See <u>Roth</u> page 3, paragraph 0044, wherein "personal

computer" is deemed to be one of "connected group of computers").

As to claim 24, <u>Roth</u> as modified discloses wherein said legacy database management

system further comprises a repository for storage of said ordered sequence of statements of said

native command language prior to execution (See <u>Roth</u> page 5, paragraphs 0066-0068, wherein

"native command language" reads on "the Operator box" part of SQL language being specified

prior to execution of the search).

As to claim 25, <u>Roth</u> as modified discloses wherein said facility further comprises a

plurality of sample XML messages (See <u>Roth</u> page 4, paragraph 0056, wherein "XML

send/receive" deemed to include plurality of XML messages).

Response to Arguments

6.   Applicant's arguments with respect to claims 1-25 have been considered but are moot in

view of the new ground(s) of rejection.

In response to applicant's argument that the claims of the present application are

patentably distinct from those of the co-pending application is acknowledged but does not seem

to be persuasive.

The Examiner maintains the provisional double patenting rejection stating that these

differences are considered obvious and do not patentably distinguish the overall appearance of

the claimed medium and method over copending application Serial No. 10/028,253 specifically

claim 1 disclosing that user terminal generates XML request to legacy database management

system, then moving on to claims 6, and 11 disclosing a converter in a user terminal for

translating document from XML to internal format. And similarly, with copending application

Serial No. 10/027,066.

A nonstatutory double patenting rejection of the obviousness-type applies to claims

directed to the same inventive concept with different appearances or differing scope, which are

patentably indistinct from each other. Nonstatutory categories of double patenting rejections

which are not the "same invention" type may be overcome by the submission of a terminal

disclaimer.

An obviousness-type double patenting rejection must be based on the obviousness

standard of 35 U.S.C. 103(a). That is, >the conflicting inventions must have overall appearances

that are basically the same, and the< differences between **>them< must either be **>minor and

patentably indistinct< or ** obvious to a designer of ordinary skill in the art ** in view of

*>analogous< prior art or case law. See MPEP 804 [R-3] the ODP rejection in the improvement

application cannot be withdrawn without a terminal disclaimer.
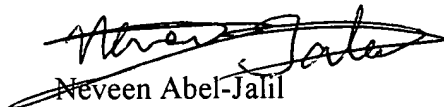

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

      Jacobs (U.S. Patent No. 6,611,843 B1) teaches converting XML to SQL on a client

terminal.

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074.

The examiner can normally be reached on 8:30AM-5:30PM EST.

      If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Neveen Abel-Jalil
December 30, 2005